



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,172	04/08/2004	Jeff Smith	08-889451US1CIP	7037

7590

10/05/2006

GOWLING LAFLEUR HENDERSON, LLP
Suite 2600
160 Elgin Street
Ottawa, ON K1P 1C3
CANADA

EXAMINER

ULRICH, NICHOLAS S

ART UNIT	PAPER NUMBER
----------	--------------

2112

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

A

Office Action Summary	Application No. 10/820,172	Applicant(s) SMITH ET AL.	
	Examiner Nicholas S. Ulrich	Art Unit 2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/8/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/8/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-16 have been examined.
2. This application is in continuation-in-part of the parent application 09987425 filed on 11/14/2001.

Specification

3. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09987425, filed 11/14/2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all non-provisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and

(a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

4. The use of the trademark Microsoft Windows, Macintosh, Microsoft Powerpoint, Outlook, Word, MS Word, and Polaris has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. When cited, the trademarks should be in the form of a superscript, for example MacintoshTM. Appropriate correction of the trademarks is required.

5. The disclosure is objected to because of the following informalities: On page 11 lines 21 and 22, when referring to Fig 4 about the contact editor frame and stationary editor frame, the numbers do not correctly match between the drawing and the explanation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. Claim 1 recites the limitation "realistically" which does not relate to anything specific and is unclear in meaning.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 8,10,13-16 are rejected under second paragraph of 35 U.S.C. 112.

Claim 8 and 10 recites the limitation "the appropriate user action" in line 1. There is insufficient antecedent basis for this limitation in the claim because claim 6 nor claim 1 does not recite the limitation "appropriate user action". Claim 8 is interpreted as being dependent on claim 2. Appropriate correction is required.

Claim 13 is in dependent form but a dependent claim cannot depend on itself. Claims 14 –16 inherit this rejection due to being dependent on claim 13.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim language is interpreted to reflect the use of computer hardware to perform the claimed method but does not recite the limitation of computer hardware causing the result to be intangible. It is suggested by the examiner to amend the claims to read "a computer-implemented method" in order to overcome the rejection. Refer to the MPEP section 2106 for statutory process claims.

10. Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the use of computer hardware to perform the methods resulting in a lack of tangible result. To be statutory the claims must define a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combinations. See MPEP section 2106 for statutory product claims.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ho (U.S. Patent 6407757).

Claim 1

Ho discloses a method of realistically displaying and interacting with electronic files comprising the steps of:

separating an electronic file into a plurality of sub-elements (*Column 7 lines 22 – 37: Ho discusses organization of material in a document into numerous pages*);

Art Unit: 2112

instantiating a frame manager object for controlling user interface frame windows
(Column 25 lines 2- 22 and Fig 7: Ho discusses a complete browsing system
along with a browsing device (740) for transforming the document and allowing
for five different controlled viewing methods of the pages);

generating a primary frame for displaying an initial sub-element (Column 37 lines
54 –56: Ho discusses generating the first page (1802) for displaying a sub
element of the “My Computer” folder).

Claim 2

Ho discloses a method comprising the step of responsive to an
appropriate user action, generating a secondary frame for another sub-element
(Fig 22 A: Ho discusses creating additionally pages by a users request(2203 and
2002) to add to the existing initial pages created (2205)).

Claim 3

Ho discloses a method wherein the frame manager object includes a list of
frames generated (Fig 17 B 1120: Ho shows an index page of contents included
in pages).

Claim 4

Ho discloses a method wherein the primary frame is singular (Fig 21
(2105) and Column 41 lines 18-30: Ho shows how the working book or primary
frame (2105) is separate and singular from other windows on the desktop).

Claim 5

Ho discloses a method wherein the step of generating the primary frame includes the step of generating an invisible frame (*Column 37 line 47 and Fig 18A: It is inherently shown that the so called working book (which is the main program for showing the plurality of created sub pages from an electronic file) can in fact be considered invisible because it is behind the initially created primary frame and serves no visual purpose*).

Claim 6

Ho discloses a method wherein the invisible frame is used to control closing an application using the frame manager object (*It is inherently shown since the working book is the controlling frame of the program, by closing it, the plurality of created sub pages will be closed resulting in the entire application closing*).

Claim 7

Ho discloses a method as claimed in Claim 2 wherein the primary frame includes a user selectable object (*Fig 18 A icon 1803*).

Claim 8

Ho discloses a method wherein the appropriate user action includes selecting the user selectable object (*Column 37 lines 52-53: the double click is used to select the user selectable object*).

Claim 9

Ho discloses a method wherein the primary frame includes a plurality of user selectable object (*Fig 18 A: 1802 is the first page or primary page and 1803 is plurality of user selectable objects*).

Claim 10

Ho discloses a method wherein the appropriate user action includes selecting one of the plurality user selectable objects (*Column 37 lines 52-53: the double click is used to select the user selectable object*).

Claim 11

Ho discloses a software architecture for graphically displaying electronic files comprising:

an application executable (*Column 41 lines 51-52: user elects to generate working book*);

a frame manager object instantiatable by the application executable for managing all frame windows needed by the application (*Fig 7 element 740*);

and an initial frame window for displaying a sub-element of a file (*Column 37 lines 54 –56: Ho discusses generating the first page for displaying a sub element of the “My Computer” folder*).

Claim 12

Ho discloses a software architecture wherein the initial frame window controls creation and destruction of further frame windows (*Fig 22: Once the first pages of a working book are created the user has control to close or create or do a plurality of other things to additional pages of the working book*).

Claim 13

Ho discloses a software architecture wherein further frame windows are each for displaying a sub-element of a file (*Column 37 lines 54-56: the sub elements of my computer are displayed on one or more subsequent pages*).

Claim 14

Ho discloses a software architecture wherein each further frame window includes an extension manager (*Column 34 lines 52-56, Column 35 lines 15-17, Column 35 line 23, and column 35 lines 29-32: Each page allows for use of program extensions including highlighting and editing*).

Claim 15

Ho discloses a software architecture wherein the extension manager controls enhancement extensions (*Column 35 lines 15-17: highlighting is an enhancement to the document*).

Claim 16

Ho discloses a software architecture wherein the extension manager controls document extensions (*Column 35 line 23: in conjunction with word-processing system allows for control of document extensions*).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas S. Ulrich whose telephone number is 571-270-

Art Unit: 2112

1397. The examiner can normally be reached on M-F 7:30 - 5:00 EST Off every other friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chameli Das can be reached on 571-272-3696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas Ulrich
2112
9/27/2006

Chameli C. Das
CHAMELI DAS
SUPERVISORY PATENT EXAMINER
9/28/06